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MAR 18 2005

OFFICE OF PETITIONS

In re Application of :
Michael Palumbo, John Baross, and Mark P. :
Evans :
Application No. 10/750,362 :
Filed: December 31, 2003 :
Attorney Docket No. ATT/2003-0254 :
Title: METHOD AND SYSTEM FOR :
RECEIVING DIGITAL CONTENT USING A :
PREPAID DIGITAL CONTENT CARD :
: DECISION ON RENEWED PETITION

This is in response to the renewed petition under 37 C.F.R. §1.47(a)¹, filed March 7, 2005.

On December 31, 2003, the application was deposited, identifying Michael Palumbo, John Baross, and Mark P. Evans as joint inventors. The application was deposited without an oath or declaration. On April 27, 2004, a "Notice to File Missing Parts of Nonprovisional Application – Filing Date Granted" (Notice) was mailed, indicating that the basic filing fee, an executed oath

¹A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 CFR §1.63.

or declaration, and a surcharge of \$130.00 were required. This Notice set a two-month period for reply.

Along with the original petition, Petitioner submitted the petition fee, the surcharge, the basic filing fee, and a four-month extension of time. Petitioner also included a declaration that has been executed by each of the joint inventors save inventor Baross.

The original petition, submitted on October 29, 2004, was dismissed via the mailing of a decision on January 7, 2005, for failure to establish that a complete copy of the application was sent to the non-signing inventor.

With this renewed petition, Petitioner has established that on January 28, 2005, a complete copy of the application was sent to 16 Pleasant Grove Road, Long Valley, NJ, 07853-3444.

Unfortunately, the last-known address for the non-signing inventor, as set forth in the original petition, is 126 Pleasant Grove Road, Long Valley, NJ, 07853-3444.

It is noted that Petitioner has included a copy of the express mail label associated with the letter of January 28, 2005, and this letter was addressed to the 16 Pleasant Grove address. The numbers "126" are handwritten and circled next to the delivery address, but the incorrect number "16" is not crossed out.

Petitioner has included a copy of the United States Postal Service's website (<http://www.usps.com/shipping/trackandconfirm.htm>) tracking results, but when the undersigned ran the same search, a different result was obtained. The search performed by the undersigned shows that the package was accepted on February 9, 2005 and signed for by one J. Hunter. A copy of this search result is enclosed. Since the letter and the express mail label each bear the wrong address, and the package was signed for by one other than the non-signing inventor, it appears that the package was both addressed and delivered to the wrong address.

For these reasons, the renewed petition under 37 C.F.R. §1.47(b) is **DISMISSED**.

Any reply must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Second Renewed Petition Under 37 C.F.R. §1.47(a)". This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski.

To help assure prompt and proper attention to your response, please see Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004) for further information on how to assist the Office in delivering your submission to the correct location. The Petitioner may wish to consider telephoning the undersigned one month after the submission is made to confirm that the documents were properly delivered.

Any renewed petition may be submitted by mail², hand-delivery³, or facsimile⁴.

The application file will be retained in the Office of Petitions for two (2) months.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.



**Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office**

Encl. Printout of the USPS online tracking results

2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

3 Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

4 (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.